

REMARKS

Claims 8, 9, 13, and 14 are presently in the application. Claims 1-7, 10, 12, 15 and 17 have been canceled. Claims 11, 16, 18 and 19 have been withdrawn.

The above amendments are being made to place the application in better condition for examination.

Claims 8, 9, 13, and 14 have been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 5,885,295 to McDaniel et al in view of US Patent No. 6,916,483 to Ralph et al.

Claim 8 is directed to a positioning tip 10 positioning a distal end portion 2a of an artificial joint stem 2 into a bone canal 4 and guiding the distal end portion 2a of the stem so as not to make direct contact with an inner surface of the bone canal 4 when the artificial joint stem 2 is inserted therein, the positioning tip 10 mounted on a cementless artificial joint stem 2 at a position near the distal end portion 2a of the stem *such that an outer circumferential surface of the positioning tip 10 faces the inner surface of the bone canal 4*, the improvement wherein said positioning tip 10 is made of a biodegradable and absorbable material *and wherein said positioning tip 10 includes means for mounting the positioning tip 10 the position near the distal end portion 2a of the stem*, wherein the means for mounting the positioning tip is at a position that is offset from the center axis of the positioning tip.

McDaniel et al is relied upon for showing a positioning jig 36 that engages with a head portion of a hip prosthesis, rather than a positioning means for the distal end portion of the

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stem. The positioning jig has an uneven shape and an axis offset from the center axis however it is not mounted at the distal end portion of the stem.

Amended claim 8 distinguishes the structure more clearly, in particular that the positioning tip is mounted on a cementless artificial joint stem at a position near the distal end portion of the stem such that an outer circumferential surface of the positioning tip faces the inner surface of the bone canal. McDaniel clearly lacks this distinguishing structural feature of the invention.

Ralph et al is combined with McDaniel et al to disclose the use of a biodegradable material. Neither of the McDaniel et al patent nor the Ralph et al patent teach or suggest means for mounting the tip on a cementless artificial joint stem near the distal end portion of the stem. McDaniel et al also shows a centralizer sleeve 116 having an axial through hole, positioned on the distal end of the stem 110, which teaches away from the means for mounting the positioning tip being at a position that is offset from the center axis of the positioning tip. Neither McDaniel et al or Ralph et al teaches or suggests a centralizer made of a biodegradable and absorbable material.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Neither McDaniel et al or Ralph et al teaches or suggests a positioning tip of the type recited in claim 8 in which the positioning tip is mounted on a cementless artificial joint stem at a position near the distal end portion of the stem such that an outer circumferential surface of the positioning tip faces the inner surface of the bone canal, the

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positioning tip being made of a biodegradable and absorbable material, the positioning tip including means for mounting the positioning tip the position near the distal end portion of the stem, and the means for mounting the positioning tip is at a position that is offset from the center axis of the positioning tip. Accordingly, claims 8, 9, 13 and 14 are not rendered obvious by the combined teachings of McDaniel et al and Ralph et al.

The examiner has provisionally rejected claims 8, 9, 13 and 14 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 11, 19, 24, and 28 of co-pending Application No. 10/938,722.

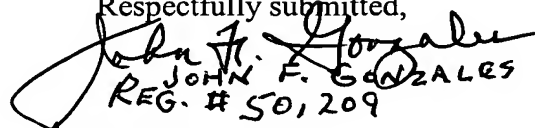
The claims in co-pending Application No. 10/938,722 call for the tip to be made from "bone supplementing material," while the claims in this application call for the tip to be made from "a biodegradable and absorbable material."

The examiner has interpreted the claims of the present application to be broader than that of '722 as claim 11 therein includes both a bone supplementing layer and biodegradable and absorbable layer.

However, independent claim 8 has been amended to require "means for mounting the positioning tip 10 at the position near the distal end portion 2a of the stem." No such language is found in any of claims 11, 19, 24, and 28 of co-pending Application No. 10/938,722. Thus, all of the claims in the present application are patentably distinct from claims 11, 19, 24, and 28 of co-pending Application No. 10/938,722.

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Entry of the amendment is respectfully solicited and reconsideration of the amended claims is requested.

Respectfully submitted,

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